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10/069,403	02/26/2002	Timo Haataja	P 290634	3628
909 7590 03/04/2009 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
POINVIL, FRANTZY				
ART UNIT		PAPER NUMBER		
3696				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/069,403

Applicant(s)

HAATAJA ET AL

Examiner

Frantzy Poinvil

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-893)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-8 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claims 14-17 are directed toward a data structure embodied in a computer media absent any computer or computerized system to perform any of the claimed functions. Applicant is reminded that a statutory claim would define structural and functional interrelationships between data structures or functional parts and a computer for performing the data functions to be

realized. The claims do not recite any functions that are tied to a computer to produce a useful result. Accordingly, claims 14-17 are rejected as being non-statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-11, 18-20 and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (US Patent No. 5,825,863).

As per claims 1 and 9, Walker discloses a system and method for providing prepaid and credit-limited telephone services to a user of a prepaid card. See the abstract. The system and method comprise:

maintaining subscriber-specific subscriber information on at least one home subscriber of a telecommunications network (see column 3, line 50 to column 4, line 17 and figure 4 of Walker);

maintaining at least two different tariff models for the home subscribers (local and long distance and international rates and roaming rates), each model containing a tariff scheme defining how to charge different calls (see column 4, lines 37-46 of Walker);

maintaining in the subscriber-specific information an indication of a tariff model to be used with the home subscriber to charge calls, the tariff model being one of the at least two

different models and the indicating the tariff model directly or indirectly (column 4, lines 37-46);

detecting the home subscriber is making a call (column 4, lines 18-36 of Walker);

determining in response to the detecting a tariff model to be used based on the indication in the home subscribers subscriber information, obtaining a tariff scheme to be used based on the determined tariff model and calculating a charge for the call according to the obtained tariff scheme. See column 4, lines 47-61.

As per claims 2 and 10, Walker discloses defining one tariff (the local rate) to be a default model which is used when no other tariff model is indicated.

As per claims 3 and 11, Walker discloses the telecommunications network offers a prepaid service to its subscribers and the at least one subscriber is a prepaid subscriber. See the abstract and column 3, lines 22-30.

Claims 18-20 and 24-25 contain limitations addressed in claim 1, and these limitations are rejected under a similar rationale.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8, 12-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (US Patent 5,825,863).

As per claims 4, 7, 8 and 14, the teachings of Walker are discussed above. Walker does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis of the voucher type indicated in the subscriber's subscriber-specific subscriber information. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Walker also teaches that, tariffs may be in time units, monetary values and unit values. Charging or billing one tariff model to a type of voucher would have been left as an agreement between users and the owners of the system of Walker. The motivation to introduce such a billing scheme in the system and method of Walker I would have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

As per claims 5 and 6, 12, in depositing funds from a voucher or billing card, the user's subscriber information must be checked and if the voucher or billing card is an allowed one (based on sufficient funds or based on correct Id, PIN or password), then continuing depositing and if the voucher is not an allowed one, terminating depositing would have been obvious to one of ordinary skill in the art to do in order to prevent depositing funds in a stolen card.

As per claim 13, 15-17, 21-23, Walker discloses a system and method for providing prepaid and credit-limited telephone services. The system and method comprise:

A memory configured to maintain subscriber information on at least one subscriber (see column 3, line 48 to column 4, line 17 of Walker). Walker further discloses using at least two different types of vouchers or payment systems such as a credit card or debit card for making deposits into subscribers' prepaid accounts (column 5, lines 2-17). Walker does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis of the voucher this subscriber is currently using. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Walker also teaches that, tariffs may be in time units, monetary values and unit values. Charging or billing one tariff model to a type of voucher would have been left as an agreement between users and the owners of the system of Walker. The motivation to introduce such a billing scheme in the system and method of Walker would have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

The system and method finding out which of the defined tariff models to be used with a subscriber from the subscriber information in defining how to charge a call would have been obvious to one of ordinary skill in the art to do especially in the case one of the subscriber's

vouchers become exhausted thus, allowing alternate means or form of payment to enable a call transaction or in the case roaming charges need to be assessed.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Frantzy Poinvil/
Primary Examiner
Art Unit 3696**

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